



DOCKETED

UNITED STATES PATENT AND TRADEMARK OFFICE

07/28/2002

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,887	04/20/2001	Kevin R. Willett	85939.000193	4285

23387 7590 10/24/2002

Stephen B. Salai, Esq.
Harter, Secrest & Emery LLP
1600 Bausch & Lomb Place
Rochester, NY 14604-2711

EXAMINER

UHLIR, NIKOLAS J

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 10/24/2002

Response:

January 24, 2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/839,887	WILLETT, KEVIN R.	
	Examiner Nikolas J. Uhlir	Art Unit 1773	
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>			
Period for Reply			
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.			
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 			
Status			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>01 October 2002</u> .			
2a) <input type="checkbox"/> This action is FINAL . 2b) <input checked="" type="checkbox"/> This action is non-final.			
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
Disposition of Claims			
4) <input checked="" type="checkbox"/> Claim(s) <u>1-20, 23-24, 26, 33-65</u> is/are pending in the application.			
4a) Of the above claim(s) _____ is/are withdrawn from consideration.			
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.			
6) <input checked="" type="checkbox"/> Claim(s) <u>1-20, 23-24, 26, 33-65</u> is/are rejected.			
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.			
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.			
Application Papers			
9) <input type="checkbox"/> The specification is objected to by the Examiner.			
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.			
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).			
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.			
If approved, corrected drawings are required in reply to this Office action.			
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.			
Priority under 35 U.S.C. §§ 119 and 120			
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).			
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:			
1. <input type="checkbox"/> Certified copies of the priority documents have been received.			
2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.			
3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).			
* See the attached detailed Office action for a list of the certified copies not received.			
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).			
a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.			
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.			
Attachment(s)			
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____	
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)	
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>14</u> .		6) <input type="checkbox"/> Other: _____	

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 33 and 34 recites the limitation "the trim portion" in the first line of each claim. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20, 23-24, 26, and 33-65 rejected under 35 U.S.C. 103(a) as being unpatentable over Junker (US4994311) in view of Ford et al. (US5545448).

The limitation(s) "to form a surface film of fused powder coating having a thickness less than .2mm" in claim 3, "selected to form a colliquefied layer having a thickness less than .2mm" in claim 15, "selected to form a contiguous colliquefaction" in claim 17, "selected to form a contiguous surface film" in claim 44, "for forming a contiguous surface film" in claim 50, ""selected to form a contiguous surface film" in claim 56, and "to form a

contiguous surface film" in claim 61 are intended use limitations and do not appear to be further limiting in so far as the structure of the product is concerned. "[I]n apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the applicant has claimed a weather seal that is coated with a heat fusible powder coating, wherein the heat fusible powder coating has the intended use of being heat fused to form a continuous or contiguous layer. The applicant has not positively claimed a weather seal having a fused coating on its surface.

3. Regarding the limitations of claim 1, wherein the applicant requires an automotive weather seal, comprising a resilient polymeric body, a metal reinforcing member connected to the body, and a heat fusible powder coating on a portion of the metal reinforcing member and the resilient polymeric body. Junker teaches a weather strip for an automobile having a metal carrier (equivalent to applicants claimed metal reinforcing member), and a resilient polymeric body (column 1, lines 55-66). The surface of the sealing strip is decorated with a coating material that is applied in powder form to the surface of the sealing strip, after which is heated and melted to fix it in place (column 2, lines 30-45). It is the examiners position that the powder on the surface of the

sealing strip constitutes a heat fusible powder coating. Thus, the limitations of claim 1 are met.

4. Regarding the limitations of claim 2, wherein the applicant requires the weatherseal to comprise a trim portion and a sealing portion, Junker teaches that the sealing strip comprises a gripping portion and a sealing portion (column 1, lines 55-60), which the examiner has interpreted to be equivalent to applicants claimed trim and sealing portions. Thus, the limitations of claim 2 are met.

5. Regarding the limitations of claim 3, wherein the applicant is claiming a quantity of powder coating to form a surface film of a fused powder coating having a thickness less than 0.2 mm. For the purpose of this examination, the examiner has interpreted this claim to simply require a quantity of powder coating. As stated above, the phrase "to form a surface film of fused powder" is an intended use limitation. The applicant fails to positively recite a fused coating on the surface of a weather seal. Thus, this limitation is met as set forth above for claim 1.

6. Regarding the limitations of claim 4, wherein the applicant requires the metal reinforcing member to be partially covered by the polymeric body. It is clear from figure 1 that the metal reinforcing member (10) is completely covered by the polymeric body. Completely covered encompasses partially covered, and thus the limitations of claim 4 are met.

7. Regarding the limitations of claim 5, wherein the applicant requires an automotive weather seal having a first portion formed of a first polymeric material and a second portion formed of a different second polymeric material, and a powder coating

on the first portion and the second portion. Junker teaches that the gripping portion is manufactured from a plastic or rubber material (column 1, lines 55-58), whereas the sealing portion is manufactured from sponge rubber (column 2, lines 8-10). It is the examiners position that sponge rubber and rubber are different polymeric materials. Junker further teaches that a powder coating such as that disclosed above for claim 1 is applied to the gripping portion weather seal for the purpose of providing a decorative colored surface (column 2, lines 12-45).

8. With respect to the limitations of claim 5, Junker fails to teach coating two portions of the weather seal that are made out of different materials with a powder coating.

9. However, Ford et al. teaches a weather seal for an automobile that has a similar structure to that of Junker in that it comprises a gripping (carrier) portion and a sealing portion. Both the gripping and sealing portion are coated with a colored coating to match the paintwork or the interior of the vehicle (column 2, lines 20-33).

10. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat both the trim and sealing portion of Junker with the decorative powder coating.

11. One would have been motivated to make this modification for aesthetic reasons, such as to match the weather seal with the paintwork and interior of an automobile, such as described in Ford et al.

12. Regarding the limitations of claim 6, wherein the applicant requires the first material to be a thermoset material and the second material to be a thermoplastic

material. Junker teaches that the gripping portion is formed from plastics or a rubber material, whereas the sealing section is formed from sponge rubber, as stated above for claim 5. The examiner interprets plastic materials, to include thermoplastics and thermosetting materials. It would be obvious to one of ordinary skill in the art at the time the invention was made to select a thermoplastic material for the gripping portion of Junker due to the fact that all plastic materials are taught as equivalent for forming the gripping portion. Rubbers are known thermosetting materials. Thus, the limitations of claim 6 are met.

13. With respect to the limitations of claim 7, wherein the applicant requires a metallic reinforcing member connected to one of the first and second portions of the weather seal. This limitation is met as set forth above for claim 1 and as shown in figure 1 of Junker.

14. Regarding the limitations of claim 8, wherein the applicant requires a colliquefaction of the powder coating to have a thickness between 0.05-0.2mm. The applicant in this claim fails to positively recite a fused coating. Rather the applicant has claimed what the powder coating is capable of, i.e. its intended use to form a colliquefied coating. Thus, the examiner has interpreted this claim to require only a heat fusible powder coating, as required by claim 1. Thus, this limitation is met.

15. Regarding the limitations of claim 9, wherein the applicant requires the powder coating to be a thermoset material and the second polymeric material is a thermoplastic material. With respect to the limitation requiring the second material to be a thermoplastic material, this limitation is met as set forth above for claim 6. Regarding

the other limitations in this claim, Junker teaches that the powder coating comprises powdery thermoplasts, half-crosslinked powdery products, or crosslinked powdery elastomers (column 2, lines 46-55). The examiner takes the position that crosslinked powdery elastomers are thermosetting materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to selected thermoset materials for the powder coating, as crosslinked powdery materials are taught to be equivalent to the other materials specified as suitable by Junker.

16. Regarding the limitations of claims 10-15 and 17. These claims are essentially identical to claims 5-9, with the only difference in claim 10 from claim 5 being the substitution of the phrase "a weatherseal body" for the phrase "a substrate" in step "a" of claim 10. Thus, these limitations are met as set forth above for claim 5-9.

17. Regarding the limitations of claim 16, wherein the applicant requires the powder coating to be selected to form a colliquefied layer having a thickness less than 0.2mm. Once again, the applicant in this claim claims a powder coating by its intended use, namely its intention to form a colliquefied layer having a specified thickness. The applicant fails to positively recite a fused coating on the surface of a weather seal. Thus, the examiner has interpreted this claim simply to require a quantity of a powder coating on the surface of a weather seal. Thus, this limitation is met as set forth above for claim 10.

18. Regarding the limitations of claim 17, wherein the applicant requires the powder coating be selected to form a contiguous colliquefaction. The examiner interprets this claim to simply require a quantity of a powder coating on the surface of a weatherseal,

as the applicant fails to positively recite a fused coating. Thus, this limitation is met as set forth above for claim 10.

19. Regarding the limitations of claim 18, wherein the applicant requires the powder coating be located to form a sealing surface. As stated above for claims 5 and 10, Junker as modified by Ford teaches coating the sealing surface with a powder coating to form a decorative surface. Thus, the limitations of claim 18 are met.

20. Regarding the limitations of claim 19, wherein the applicant requires the powder coating to have a gloss appearance. Although Junker does not specifically teach this limitation, it is the examiners position that the powder coating of Junker will be glossy "to some degree." Thus, the limitations of this claim are met as set forth above for claim 10.

21. Regarding the limitations of claim 20, wherein the applicant requires a weatherseal for sealing an interface between two confronting surfaces in an automotive vehicle, wherein the weatherseal comprises a polymeric base formed of a first material, a resilient sealing portion formed for contacting one of the confronting surface, wherein the resilient portion is formed from a second material, and a heat fusible powder coating on at least a portion of the base and the sealing portion. This limitation is met as set forth above for claim 5, as the applicant interprets the gripping portion of Junker to be equivalent to applicants claimed "base" portion.

22. Regarding the limitations of claim 23, wherein the applicant requires the base to include a trim portion, wherein the powder coating is on the trim portion. This limitation is met as set forth above for claim 20.

23. Regarding the limitations of claim 24, wherein the applicant requires a metallic reinforcing member in the base. This limitation is met as set forth above for claim 20.

24. Regarding the limitations of claim 26, wherein the applicant requires the base to further comprise a trim portion formed of a different material than the sealing portion, wherein the powder coating is on the trim portion. This limitation is met as set forth above claim 20.

25. Regarding the limitations of claim 33, wherein the applicant requires the trim portion to be a thermoplastic material. This limitation is met as set forth above for claim 6, as the examiner interprets the gripping portion of Junker to be equivalent to the claimed trim portion.

26. Regarding the limitations of claim 34, wherein the applicant requires the trim portion to be a thermoset material. This limitation is met as set forth above for claim 6, as the examiner interprets the sealing portion of Junker to be equivalent to the claimed "trim portion."

27. Regarding the limitations of claim 35, this claim is similar to that of claim 5, with the only difference being the use of the phrase "a heat fusible powder" in part "b" of claim 35. These limitations are met as set forth above for claim 5.

28. Regarding the limitations of claim 36, wherein the applicant requires on of the first and second parts to form a trim portion of the weatherseal. This limitation is met as set forth above for claim 5, as either the base or the sealing portion of Junker could be interpreted to be a "trim" portion.

29. Regarding the limitation of claim 38, wherein the applicant requires the substrate to be substantially "U" shaped. It is clear from figures 1 and 3 of Junker that the substrate has the required shape. Thus, this limitation is met.

30. Regarding claim 39, wherein the applicant requires the substrate to include a metal reinforcing member. This limitation is met as set forth above for claim 35.

31. Regarding claim 40, wherein the applicant requires a weatherseal having a polymeric body, a metal reinforcing member connected to the body, one of the body and the reinforcing member selected to engage an automotive vehicle, and a powder coating on a portion of the reinforcing member and the polymeric body. These limitations are met as set forth above for claim 39.

32. Regarding the limitations of claim 41, wherein the applicant requires the polymeric body to include a trim portion. This limitation is met as set forth above for claim 39.

33. Regarding claims 42-43. These claims are substantially similar to claims 35-36, and thus are met by the same reasoning as set forth above for those claims.

34. Regarding claim 44, wherein the applicant requires a vehicle weatherseal comprising a thermoplastic weatherseal body, and a heat fusible powder coating to form a contiguous surface film on the surface of the thermoplastic weatherseal body. The examiner has interpreted this claim as simply requiring a heat fusible powder coating on the surface of a thermoplastic weatherseal body, as the applicant has claimed a coating in terms of its intended use and thus fails to positively recite a fused coating on the surface of a weatherseal body. Thus, these limitations are met as set forth above for

claim 6, wherein the examiner interprets the grip portion of Junker in figure 1 to be the thermoplastic body claimed.

35. Regarding claim 45, wherein the applicant requires the weatherseal body to comprise a trim portion and a sealing portion, and the heat fusible powder coating is on at least one of the sealing portion and trim portion. This limitation is met as set forth above for claim 6.

36. Regarding claim 46, wherein the applicant requires one of the trim and the sealing portion to have a foamed, cellular, or a sponge structure. Junker teaches that the sealing portion is made of a sponge rubber (column 2, lines 5-12). Thus, this limitation is met.

37. Regarding claims 47-48, wherein the applicant requires a reinforcing member made of metal in the weatherseal body. This limitation is met as set forth above for claim 45, as Junker teaches a metallic reinforcement in the weatherseal, as shown in figures 1 and 3.

38. Regarding claim 49 wherein the applicant requires the heat fusible powder coating to be one of a thermoplastic and a thermoset material. This limitation is met as set forth above for claim 9.

39. Regarding claims 50-55. These claims are similar to claims 44-49, with the only difference being the use of the term "powder coating" in part "b" of claim 50. Thus, the limitations of claims 50-54 are met as set forth above for claims 44-49.

40. Regarding the limitations of claims 56-60. These claims are similar to claims 44-49, with the only difference being that the applicant requires a thermosetting

weatherseal body. The limitations of claims 56-60 are met as set forth above for claims 44-49, with the only change being that it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a rubber (a known thermosetting material) material to form the weatherseal body in Junker, as this material is taught to be equivalent to the other materials listed as suitable for forming the weatherseal.

41. Regarding the limitations of claim 61, wherein the applicant requires a vehicular weather seal comprising a thermosetting weatherseal body, and a thermosetting powder coating to form a contiguous surface film on a portion of the thermoset weatherseal body. The examiner has interpreted this claim to require only a thermosetting powder coating on the surface of a thermosetting weatherseal body, as the applicant has claimed the intended use of the powder coating, and thus has not positively recited a fused coating on the surface of a weatherseal. This limitation is met as set forth above for claim 56.

42. Regarding claim 62, wherein the applicant requires the thermosetting weatherseal to include a sealing portion and a trim portion and the thermosetting powder coating is on at least one of the sealing and trim portions. This limitation is met as set forth above for claim 57.

43. Regarding claims 63-65, these limitations are met as set forth above for claims 58-60.

Examiner Note

44. After careful review of the specification and the claims, and in the interest of expediting prosecution, it is the examiners humble opinion that the applicant's invention may reside in a process for manufacturing a coated weatherseal and not in the product produced. It seems that the applicants purpose is to provide a **process** for forming a weatherseal that overcomes the compatibility issues encountered when using processes of the prior art (see page 2, 1st paragraph of the specification). The examiner acknowledges that in this portion that it is also the applicant's intention to form weatherseals having coatings that are lightweight, or have coatings only on certain portions of the weatherseal. However, through close examination of the prior art it is the examiners position that these features are known, even though a different process may form them. Of course, no presumption of Patentability for the process should be assumed from this statement, as further search and examination of a process would be required. Regarding the claims of the current invention, it should further be noted that many of the claims are **extremely** broad, as weather seals having a resilient polymeric body and a metal reinforcing member are spurious in number, and that a heat fusible powder coating is read on by something as simple as dust, as dust is comprised of silica and silica is heat fusible.

Information Disclosure Statement

45. The examiner has considered the information disclosure statement filed 10/3/02. A copy of the signed PTO form 1449 accompanies this office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 703-305-0179. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0389.

AM
nju
October 18, 2002


STEVAN A. RESAN
PRIMARY EXAMINER